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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,250	03/28/2000	Anthony John Olivier	U 012693-7	5335

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EXAMINER

NGUYEN, TAM M

ART UNIT PAPER NUMBER

1764

DATE MAILED: 11/27/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/537,250

Applicant(s)

OLIVIER ET AL.

Examiner

Tam M. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The rejection of claims 2, 8, and 9 under 35 USC § 112 is withdrawn by the examiner in view of the amendment filed on August 29, 2001.

The rejection of claims 1-11 under 35 USC § 103 is withdrawn by the examiner in view of the amendment filed on August 19, 2001.

A new rejection follows.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The expression “in the range of C₁₅ and greater.....in the range C₃₅ and less” in lines 3-6 of claim 2 renders the claim indefinite because it is unclear if the feedstock of claim 2 contains only a heavy fraction since any hydrocarbons having carbon atoms equal or greater than 15 (e.g., C₂₀ or C₃₀) can be in the light, medium, or heavy fraction.

The expression “in the range C₃₀..... in the range C₂₃ and less” in lines 4-9 of claim 3 renders the claim indefinite because it is unclear if a hydrocarbon having carbon atoms of 30 would be in the hard wax or the medium wax.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Ireland et al. (4,041,097).

Ireland discloses a process for separating a Fishcher-Tropsch derived paraffinic hydrocarbon feedstock, which comprises light, medium, and heavy paraffins, by feeding the feedstock into a distillation column to produce an overhead stream, a side stream, and a bottom stream. Ireland does not specifically disclose that the side stream and the bottom stream are usable wax products. However, any wax is usable. Therefore, the limitation is inherent in the reference. Ireland does not specifically disclose the range of carbon atoms in light, medium, heavy fractions in the feedstock. However, the limitation is inherent in the reference because the Ireland feedstock is similar to the claimed process. (See col. 2, line 52 through col. 3, line 23; col. 7, lines 39-61; claims 1 and 2)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3-5 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ireland et al. (4,041,097).

Ireland does not specifically disclose the operating conditions of the distillation column and does not disclose the dimensions and the characteristics of the column.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Ireland process by utilizing the claimed operating conditions because of the similarities between the claimed process and the Ireland process in terms of feedstock and products. Therefore, it would be expected that the results would be the same or similar when operating the Ireland process under the claimed operating conditions.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Ireland process by utilizing a distillation column having the claimed dimensions and the claimed physical characteristics because of the similarities between the claimed process and the Ireland process. Therefore, it would be expected that the results would be the same or similar when using a distillation column having the claimed dimensions and the claimed physical characteristics in the Ireland process.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claims 1-5 above, and further in view of Farnham (4,295,936).

Ireland does not specifically disclose that the bottom fraction is cooled and recycled back to the column. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Ireland process by recycling about 10% of the bottom fraction back to the column because Farnham discloses that pumping costs are saved and the overall degradation rate is lower when recycling less than one-fifth the amount of cooled bottoms to the column. (See col. 4, lines 15-23)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam M. Nguyen whose telephone number is (703) 305-7715. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode can be reached on 703 308 4311. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Tam Nguyen/ TN
November 9, 2001


Walter D. Griffin
Primary Examiner